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Lisa M. Hemmendinger
Banner & Witcoff
1001 G Street, NW
Washington, DC 20001

In re Application of :
BESCHORONER, et al. :
Application No.: 10/527,587 :
PCT No.: PCT/US03/29251 : DECISION ON PETITION
Int. Filing Date: 17 September 2003 :
Priority Date: 19 September 2002 : UNDER 37 CFR 1.47(a)
Atty. Docket No.: 00241.00003 :
For: GROWTH OF FOREIGN CELLS IN FETAL :
ANIMALS FACILITATED BY CONDITIONAL :
AND SELECTIVE DESTRUCTION OF HOST :
CELLS :
:

This decision is in response to the applicant's "PETITION UNDER 37 C.F.R. § 1.47(a)" filed 21 February 2006 in the United States Patent and Trademark Office (USPTO). As authorized the \$200.00 petition fee will be deducted from deposit account 19-0733.

BACKGROUND

On 17 September 2003, applicant filed international application PCT/US03/29251 which claimed priority to an earlier U.S. application filed 19 September 2002. Pursuant to 37 CFR 1.495, the thirty-month period for paying the basic national fee in the United States was set to expire at midnight on 19 March 2005.

On 14 March 2005, applicant filed a transmittal letter for entry into the national stage in the United States which was accompanied by the requisite basic national fee as required by 35 U.S.C. 371(c)(1); an Information Disclosure Statement and a First preliminary amendment.

On 18 July 2005, applicant was mailed a "Notification of Missing Requirements" (Form PCT/DO/EO/905) informing applicant that an executed oath or declaration of the inventors in compliance with 37 CFR 1.497(a)-(b) was required. Applicant was afforded two months to file the required response and advised that this period could be extended pursuant to 37 CFR 1.136(a).

On 21 February 2006, applicant filed the present petition under 37 CFR 1.47(a) to accept the filed declaration without the signature of joint inventors Carlos E. Sosa and Scott C. Thompson accompanied by a petition for a five-month extension of time and payment of the appropriate petition fee. With the filing of the petition for a five-month extension of time and payment of the petition fee, in addition to 20 February 2006 being a federal holiday, the present

response is considered timely filed.

DISCUSSION

A petition under 37 CFR 1.47(a) must be accompanied by (1) the fee under 37 CFR 1.17(i), (2) factual proof that the missing joint investor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the missing inventor, and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and on behalf of the non-signing joint inventor. With the filing of the present petition and accompanying papers, applicant has satisfied items 1, 3 and 4.

As to item (2), Section 409.03(d) of the Manual of Patent Examining Procedure (MPEP) states, in part: Where inability to find or reach a nonsigning inventor "after diligent effort" is the reason for filing under 37 CFR 1.47, a statement of facts should be submitted that fully describes the exact facts which are relied on to establish that a diligent effort was made.

The fact that a nonsigning inventor is on vacation or out of town and is therefore temporarily unavailable to sign the declaration is not an acceptable reason for filing under 37 CFR 1.47... The statement of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein. Statements based on hearsay will not normally be accepted. Copies of documentary evidence such as Internet searches, certified mail return receipts, cover letters of instructions, telegrams, that support a finding that the nonsigning inventor could not be found or reached should be made part of the statement. The steps taken to locate the whereabouts of the nonsigning inventor should include a statement of facts. It is important that the statement contain facts as opposed to conclusions.

Applicant has provided a declaration from Dr. Nathan D. Bills to support the contention that joint inventors Carlos E. Sosa and Scott C. Thompson cannot be located to execute the declaration and power of attorney document. Regarding inventor Sosa, Dr. Bills references attempts to locate a current address for the inventor through the use of Qwest DexOnline and Google. However, applicant has not included copies of these search results; these results are necessary in order perfect applicant's statement of diligent effort to locate inventor Sosa.

As to inventor Thompson, applicant references a returned Federal Express letter, but has not included a copy. It appears that the only attempt to locate a current address for the inventor after the letter was returned was a search of the phone book for the area surrounding Mr. Thompson's last known address. This is insufficient. Applicant should make use of internet search engines and/or employee contacts in a similar manner to those employed in attempting to locate inventor Sosa.

For the reasons stated above, it is not possible to grant applicant's petition at this time.

CONCLUSION

For the reasons stated above, applicant's petition under 37 CFR 1.47(a) is **DISMISSED without prejudice.**

Any reconsideration on the merits of this petition must be filed within **TWO (2) MONTHS** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)" Extensions of time may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be directed to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



Derek A. Putonen
Attorney Advisor
Office of PCT Legal Administration
Tel: (571) 272-3294
Fax: (571) 273-0459